

### **REMARKS**

The Examiner is thanked for the performance of a thorough search. By this amendment, Claims 1–4, 6–9, 11, 12, 15–17, 20, 29, 33, 38, 39, 41–44, 46, 47, 50–61, 68, 71, and 72 have been amended. Claims 73–95 have been added. Claims 5, 10, 13, 14, 27, 28, 34, 35, 40, 45, 48, 49, 62, 63, 69, and 70 have been canceled. Hence, Claims 1–4, 6–9, 11, 12, 15–26, 29–33, 36–39, 41–44, 46, 47, 50–61, 64–68, and 71–95 are pending in this application.

All issues raised in the Office Action are addressed hereinafter.

#### **I. REQUEST FOR INTERVIEW**

Due to the nature of the amendments, to expedite examination of the application, Applicants respectfully request that the Examiner contact Applicants' representative, Karl Rees, at the number indicated at the end of this response, for an interview just prior to or in the course of her examination of the amended claims.

#### **II. ADDED CLAIMS / AMENDMENTS**

The added claims and amendments to the claims do not add any new matter to this application. The added claims and the amendments are supported by at least Applicants' original Specification.

Claims 5, 10, 13, 14, 27, 28, 34, 35, 40, 45, 48, 49, 62, 63, 69, and 70 have been canceled to allow for examination of alternative dependent claims, and not for any reason related to the patentability of those claims.

The added claims are patentable for at least the following reasons.

### CLAIM 78

The cited references fail to teach or suggest many elements of Claim 78. For example, none of the cited references teach that an **“intercepting device”**—a device that intercepts “a request for a first service provided at a server operated by the provider” that “originat[es] from the client and [is] directed to the provider”—**determines a “class of service to which a user associated with the identity is entitled” on the basis of “a request for a first service.”** For at least this reason, Claim 78 is patentable over the cited references.

### CLAIM 79

The cited references also fail to teach or suggest the method of Claim 79. For example, none of the references teach that **“based on the [determined] class of service,”** an intercepting device **“refuses to transmit the request to the provider.”** For at least this reason, Claim 79 is patentable over the cited references.

### CLAIM 81

The cited references also fail to teach or suggest the method of Claim 81. For example, none of the references teach that **“based on the [determined] class of service,”** an intercepting device, **“generat[es] a modified request** for [a] particular service based on the request for the first service.” For at least this reason, Claim 81 is patentable over the cited references.

### CLAIM 77

The cited references also fail to teach or suggest the method of Claim 77. For example, none of the references teach that the step of **“billing the service provider for providing [a] service”** is performed on the basis of messages intercepted at an

intercepting device. Rather, the only entity billed in the cited references is the service requestor. For at least this reason, Claim 77 is patentable over the cited references.

### **THE REMAINING ADDED CLAIMS**

Each of the added claims not discussed above depend from one of Claims 1, 38, or 78, and are patentable for at least the reason that, as discussed herein, Claims 1, 38, and 78 are patentable. In addition, each of the added claims not discussed above recites at least one feature that independently renders it patentable. However, to expedite prosecution in light of the fundamental differences already identified, further arguments for each independently patentable feature of the added claims not discussed above are not provided at this time. Applicants reserve the right to further point out the differences between the cited art and the novel features recited in the dependent claims.

### **III. CLAIM REJECTIONS BASED ON 35 U.S.C. § 103**

#### **A. Hosea, Liu, and Oliver**

Claims 1-7, 11-24, 26-28, 31-33, 38-42, 46-59, 61-63, and 66-68 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over U.S. Patent Application No. 2002/0138331 (hereinafter *Hosea*) in view of U.S. Patent Application No. 2002/0027901 (hereinafter *Liu*) and further in view of U.S. Patent Application No. 2002/0133412 (hereinafter *Oliver*). This rejection is respectfully traversed.

### **CLAIM 1**

Claim 1 presently recites, among other elements:

intercepting a message that has been sent from a first participant to a second participant prior to said message arriving at said second participant;

wherein intercepting the message is performed by  
an intercepting device deployed between the  
first participant and the second participant,  
wherein the message is addressed to said  
second participant;

...

wherein the intercepting device is managed by a  
third party that is different from said service  
requestor and said service provider  
determining the identity of the first participant based on  
said identifier information in said message;  
based on the intercepted message, software managed by the  
third party performing the steps of:  
determining whether said message has billing  
implications;  
if said message has billing implications, sending  
data to a billing service, the data including  
information related to the identity.

The method of Claim 1 allows a third party, other than a service requestor or service provider, to send information to a billing service based on messages intercepted by an intercepting device operated by the third party. The intercepting device is deployed between the service requestor, so that messages flow between the service requestor and service provider as depicted below:

REQUEST: Service Requestor → Intercepting Device → Service Provider

REPLY: Service Provider → Intercepting Device → Service Requestor

The intercepting device may be, for example, an HTTP proxy server through which messages from the service requestor pass to the service provider and vice versa. The third party may be, for example, an access provider such as an Internet Service Provider (ISP) through which the service requestor is given access to the service provider. The service requestor may be, for example, customers of the access provider. Thus, among other purposes, the method of Claim 1 may be used by an access provider to bill its customers on behalf of a service provider for services provided to the customers by the service provider.

The cited references fail to teach or suggest anything like the method of Claim 1. For example, *Hosea* discloses the use of an HTTP proxy server to modify content returned from a service provider based on user “personalization” profiles. As the Office Action acknowledges, *Hosea* is silent as to any of the billing-related steps in Claim 1.

*Liu*, meanwhile, discloses an anonymization server through which communications may be established between two parties without either party sharing their address. As discussed in previous responses, Applicants’ disagree that *Liu*’s techniques has anything to do with “intercepting a message,” as recited in Claim 1. However, even if *Liu*’s techniques were applicable to “intercepting a message” as recited in Claim 1, *Liu* also fails to disclose any of the billing-related steps of Claim 1. Again, the Office Action acknowledges this deficiency.

Finally, *Oliver* discloses a technique for delegating user registration and profiling services to a third party. *See Oliver* at ¶¶ [0080]–[0086]. In *Oliver*, after a service provider receives a message from a service provider, the service provider sends a token to a third-party Clickshare service so as to authenticate the user who sent the message and retrieve the user’s profile. The Clickshare service logs transactions and provides billing services based on the logged transactions. *Oliver* at ¶ [0133].

*Oliver* is alleged to teach the billing-related steps of Claim 1 because, as alleged by the Office Action, *Oliver* teaches “determining billing implications from [a] log that comes from the messages.” The Office Action apparently misunderstands *Oliver*’s billing service. *Oliver*’s billing service, as explained in ¶ [0133], **is based on logged “user transactions,” not messages**. A transaction is not a message.

Even if, in its allegation that the “log comes from the messages,” the Office Action intends to allege that the *Oliver*’s transaction log is created based on messages, the Office Action is still in error. The “messages” upon which *Oliver*’s transaction records are based are “record[s] of [a] service provided” by the service provider. *Oliver* at ¶ [0133]. These **records are sent to the Clickshare service by the service provider** after the service provider has “provided service to a validated user.” At best, then, *Oliver* may be seen as teaching that billing may be performed on the basis of messages sent by a

service provider to a third party informing the third party that the service provider has transacted with a client.

*Oliver*'s records that inform the Clickshare service of a transaction are fundamentally different than the messages upon which the steps of Claim 1 are based. *Oliver*'s records are neither messages between a service provider and a service requestor, nor are they in any way "intercepted" by an intercepting device operated by a third party. Nor is there any evidence that the Clickshare service would be capable of providing billing services on the basis of a message communicated between the service requestor or service provider. *Oliver*'s billing steps are therefore not performed on the basis of anything like the message of Claim 1.

Accordingly, *Oliver* fails to teach or suggest at least the steps of **"based on the intercepted message . . . determining whether said message has billing implications; [and] if said message has billing implications, sending data to a billing service."**

Moreover, there would be no motivation to combine *Oliver* with the other references. Because *Oliver* specifically requires that the service provider notify the billing service provider of the service being provided, there would be no advantage for a third party to, for example, modify *Hosea*'s HTTP Proxy to provide the billing services of *Oliver*'s Clickshare service. *Hosea*'s HTTP Proxy would still have to rely on the service provider to send records, apart from the messages sent by the service provider to the service requestor, informing the HTTP Proxy of services that were provided to the service requestor. The service provider, meanwhile, would find such an arrangement disadvantageous. Since the HTTP proxy to which the service provider was required to send messages would change depending on the service requestor (i.e. different customers access the internet through different ISPs operating different HTTP proxies), the service provider would need to reconfigure its servers to dynamically identify the appropriate HTTP proxy to which the service provider should send its records. Furthermore, the service provider would lose a primary benefit of *Oliver*'s technique, in that the service provider would need to rely on disparate third parties for authentication and profiling instead of Clickshare's centralized service. For at least these reasons, such a modification

would frustrate one of the main purposes of the Clickshare service. In fact, such a modification would require more work on behalf of third parties and the service provider to achieve the same effect as a single third party operating the Clickshare service separately, without any added advantages.

For at least the foregoing reason, the combination of *Hosea*, *Liu*, and *Oliver* fails to teach or suggest at least one feature of independent Claim 1. Therefore, the combination of *Hosea*, *Liu*, and *Oliver* does not render Claim 1 obvious under 35 U.S.C. § 103. Reconsideration is respectfully requested.

### **INDEPENDENT CLAIM 38**

Independent Claim 38 also recites features argued above with relation to Claim 1, although Claim 38 is expressed in another format. Because Claim 38 has at least one of the features described above for Claim 1, Claim 38 is therefore allowable over the combination of *Hosea*, *Liu*, and *Oliver* for at least one of the same reasons as given above for Claim 1. Reconsideration is respectfully requested.

### **DEPENDENT CLAIMS 2-7, 11-24, 26-28, 31-33, 39-42, 46-59, 61-63, AND 66-68**

Each of Claims 2-7, 11-24, 26-28, 31-33, 39-42, 46-59, 61-63, and 66-68 depends from one of Claims 1 or 38, and includes the above-quoted features of its parent claim by dependency. Thus, the combination of *Hosea*, *Liu*, and *Oliver* also fails to teach or suggest at least one feature found in Claims 2-7, 11-24, 26-28, 31-33, 39-42, 46-59, 61-63, and 66-68. Therefore, the combination of *Hosea*, *Liu*, and *Oliver* does not render obvious Claims 2-7, 11-24, 26-28, 31-33, 39-42, 46-59, 61-63, and 66-68.

Reconsideration of the rejection is respectfully requested.

In addition, each of Claims 2-7, 11-24, 26-28, 31-33, 39-42, 46-59, 61-63, and 66-68 recites at least one feature that independently renders it patentable. For example, **Claim 2** recites, among other elements:

in response to identifying, based on the intercepted message, that the service is being or has been provided, billing one of the service requestor or service provider for said service.

Claim 2's method of billing is fundamentally different than *Oliver*'s method of billing in that it relies on an intercepting device to identify which services are being or have been provided, instead of relying on the service requestor to identify the services being provided. *See Oliver* at ¶ [0144] (indicating that the server of the service provider is relied upon to identify the services being provided). There are many advantages to this arrangement. For example, whereas in *Oliver* a customer might be billed for a service even though that service never actually reached the customer's ISP, Claim 2 guarantees that a customer will not be billed for services that are sent from a service provider, but never received by the intercepting device.

To expedite prosecution in light of the fundamental differences already identified, further arguments for each independently patentable feature of Claims 2-7, 11-24, 26-28, 31-33, 39-42, 46-59, 61-63, and 66-68 are not provided at this time. Applicants reserve the right to further point out the differences between the cited art and the novel features recited in the dependent claims.

**B. Hosea, Liu, Oliver, and Manabe.**

Claims 8, 10, 43 and 45 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over *Hosea, Liu* and *Oliver* in view of U.S. Patent No. 5,339,239 (hereinafter *Manabe*). The rejection is respectfully traversed.

Each of Claims 8, 10, 43 and 45 is dependent upon independent Claim 1 or 38. As discussed in section A above, *Hosea, Liu* and *Oliver* fails to teach or suggest one or more features of Claims 1 and 38. The one or more features, identified above, which are missing from *Hosea, Liu* and *Oliver*, are also missing from *Manabe*. In fact, the Office Action did not rely upon *Manabe* for teaching the one or more features. Consequently, the combination of *Hosea, Liu, Oliver*, and *Manabe* fails to teach or suggest one or more



features of Claims 8, 10, 43 and 45. Thus, Claims 8, 10, 43 and 45 are patentable over the combination of *Hosea*, *Liu*, *Oliver*, and *Manabe*.

Additionally, each of the dependent claims recites at least one additional feature that independently renders it patentable over the combination of *Hosea*, *Liu*, *Oliver*, and *Manabe*. However, to expedite prosecution in light of the fundamental differences already identified, further arguments for each independently patentable feature of Claims 8, 10, 43 and 45 are not provided at this time. Applicants reserve the right to further point out the differences between the cited art and the novel features recited in the dependent claims.

**C. Hosea, Liu, Oliver, Manabe and Hartley-Urquhart.**

Claims 9 and 44 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over *Hosea* in view of *Liu* and *Oliver* and *Manabe* and further in view of U.S. Patent No. 6,167,385 (hereinafter *Hartley-Urquhart*). The rejection is respectfully traversed.

Each of Claims 9 and 44 is dependent upon independent Claim 1 or 38. As discussed in section A above, *Hosea*, *Liu* and *Oliver* fails to teach or suggest one or more features of Claims 1 and 38. The one or more features, identified above, which are missing from *Hosea*, *Liu* and *Oliver*, are also missing from *Manabe* and *Hartley-Urquhart*. In fact, the Office Action did not rely upon *Manabe* or *Hartley-Urquhart* for teaching the one or more features. Consequently, the combination of *Hosea*, *Liu*, *Oliver*, *Manabe*, and *Hartley-Urquhart* fails to teach or suggest one or more features of Claims 9 and 44. Thus, Claims 9 and 44 are patentable over the combination of *Hosea*, *Liu*, *Oliver*, *Manabe*, and *Hartley-Urquhart*.

Additionally, each of the dependent claims recites at least one additional feature that independently renders it patentable over the combination of *Hosea*, *Liu*, *Oliver*, *Manabe*, and *Hartley-Urquhart*. However, to expedite prosecution in light of the fundamental differences already identified, further arguments for each independently patentable feature of Claims 9 and 44 are not provided at this time. Applicants reserve

the right to further point out the differences between the cited art and the novel features recited in the dependent claims.

**D. Hosea, Liu, Olivier, and Clarke.**

Claims 25 and 60 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over *Hosea* in view of *Liu* and *Oliver* and in further view of U.S. Patent No. 5,502,636 (hereinafter *Clarke*). The rejection is respectfully traversed.

Each of Claims 25 and 60 is dependent upon independent Claim 1 or 38. As discussed in section A above, *Hosea*, *Liu* and *Oliver* fails to teach or suggest one or more features of Claims 1 and 38. The one or more features, identified above, which are missing from *Hosea*, *Liu* and *Oliver*, are also missing from *Clark*. In fact, the Office Action did not rely upon *Clark* for teaching the one or more features. Consequently, the combination of *Hosea*, *Liu*, *Oliver*, and *Clark* fails to teach or suggest one or more features of Claims 25 and 60. Thus, Claims 25 and 60 are patentable over the combination of *Hosea*, *Liu*, *Oliver*, and *Clark*.

Additionally, each of the dependent claims recites at least one additional feature that independently renders it patentable over the combination of *Hosea*, *Liu*, *Oliver*, and *Clark*. However, to expedite prosecution in light of the fundamental differences already identified, further arguments for each independently patentable feature of Claims 25 and 60 are not provided at this time. Applicants reserve the right to further point out the differences between the cited art and the novel features recited in the dependent claims.

**E. Obviousness under 35 U.S.C. § 103(a): Hosea, Liu, and Hahn.**

Claims 29, 30, 64 and 65 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over *Hosea* in view of *Liu* and in further view of U.S. Patent No. 6,704,612 (*Hahn*). The rejection is respectfully traversed.

Each of Claims 29, 30, 64 and 65 is dependent upon independent Claim 1 or 38. As discussed in section A above, *Hosea* and *Liu* fail to teach or suggest one or more features of Claims 1 and 38. The one or more features, identified above, which are missing from *Hosea* and *Liu*, are also missing from *Hahn*. In fact, the Office Action did not rely upon *Hahn* for teaching the one or more features. Consequently, the combination of *Hosea*, *Liu*, and *Hahn* fails to teach or suggest one or more features of Claims 29, 30, 64 and 65. Thus, Claims 29, 30, 64 and 65 are patentable over the combination of *Hosea*, *Liu*, and *Hahn*.

Additionally, each of the dependent claims recites at least one additional feature that independently renders it patentable over the combination of *Hosea*, *Liu*, and *Hahn*. However, to expedite prosecution in light of the fundamental differences already identified, further arguments for each independently patentable feature of Claims 29, 30, 64 and 65 are not provided at this time. Applicants reserve the right to further point out the differences between the cited art and the novel features recited in the dependent claims.

***F. Obviousness under 35 U.S.C. § 103(a): Hosea, Liu, Oliver, and Block.***

Claims 34, 35, 69 and 70 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over *Hosea* in view of *Liu* and *Oliver* and U.S. Patent No. 5,960,416 (hereinafter *Block*). This rejection is respectfully traversed. The rejection is respectfully traversed.

Each of Claims 34, 35, 69 and 70 is dependent upon independent Claim 1 or 38. As discussed in section A above, *Hosea*, *Liu* and *Oliver* fails to teach or suggest one or more features of Claims 1 and 38. The one or more features, identified above, which are missing from *Hosea*, *Liu* and *Oliver*, are also missing from *Block*. In fact, the Office Action did not rely upon *Clark* for teaching the one or more features. Consequently, the combination of *Hosea*, *Liu*, *Oliver*, and *Block* fails to teach or suggest one or more features of Claims 34, 35, 69 and 70. Thus, Claims 34, 35, 69 and 70 are patentable over the combination of *Hosea*, *Liu*, *Oliver*, and *Block*.

Additionally, each of the dependent claims recites at least one additional feature that independently renders it patentable over the combination of *Hosea*, *Liu*, *Oliver*, and *Block*. However, to expedite prosecution in light of the fundamental differences already identified, further arguments for each independently patentable feature of Claims 34, 35, 69 and 70 are not provided at this time. Applicants reserve the right to further point out the differences between the cited art and the novel features recited in the dependent claims.

**G. Obviousness under 35 U.S.C. § 103(a): Hosea, Liu, and Tealdi.**

Claims 36 and 71 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over *Hosea* in view of *Liu* further in view of U.S. Patent Application No. 2001/0029482 (hereinafter *Tealdi*). This rejection is respectfully traversed. The rejection is respectfully traversed.

Each of Claims 36 and 71 is dependent upon independent Claim 1 or 38. As discussed in section A above, *Hosea* and *Liu* fail to teach or suggest one or more features of Claims 1 and 38. The one or more features, identified above, which are missing from *Hosea* and *Liu*, are also missing from *Tealdi*. In fact, the Office Action did not rely upon *Tealdi* for teaching the one or more features. Consequently, the combination of *Hosea*, *Liu*, and *Tealdi* fails to teach or suggest one or more features of Claims 36 and 71. Thus, Claims 36 and 71 are patentable over the combination of *Hosea*, *Liu*, and *Tealdi*.

Additionally, each of the dependent claims recites at least one additional feature that independently renders it patentable over the combination of *Hosea*, *Liu*, and *Tealdi*. However, to expedite prosecution in light of the fundamental differences already identified, further arguments for each independently patentable feature of Claims 36 and 71 are not provided at this time. Applicants reserve the right to further point out the differences between the cited art and the novel features recited in the dependent claims.

***H. Obviousness under 35 U.S.C. § 103(a): Hosea, Liu, Tealdi, and Oliver.***

Claims 37 and 72 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Hosea* in view of *Liu*, and *Tealdi* further in view of *Oliver*. The rejection is respectfully traversed.

Each of Claims 37 and 72 is dependent upon independent Claim 1 or 38. As discussed in section A above, *Hosea*, *Liu* and *Tealdi* fails to teach or suggest one or more features of Claims 1 and 38. The one or more features, identified above, which are missing from *Hosea*, *Liu* and *Oliver*, are also missing from *Block*. In fact, the Office Action did not rely upon *Clark* for teaching the one or more features. Consequently, the combination of *Hosea*, *Liu*, *Oliver*, and *Tealdi* fails to teach or suggest one or more features of Claims 37 and 72. Thus, Claims 37 and 72 are patentable over the combination of *Hosea*, *Liu*, *Oliver*, and *Tealdi*.

Additionally, each of the dependent claims recites at least one additional feature that independently renders it patentable over the combination of *Hosea*, *Liu*, *Oliver*, and *Tealdi*. However, to expedite prosecution in light of the fundamental differences already identified, further arguments for each independently patentable feature of Claims 37 and 72 are not provided at this time. Applicants reserve the right to further point out the differences between the cited art and the novel features recited in the dependent claims.

#### IV. CONCLUSION

For the reasons set forth above, all of the pending claims are now in condition for allowance. The Examiner is respectfully requested to contact the undersigned by telephone relating to any issue that would advance examination of the present application.

A petition for extension of time, to the extent necessary to make this reply timely filed, is hereby made. If any applicable fee is missing or insufficient, throughout the pendency of this application, the Commissioner is hereby authorized to any applicable fees and to credit any overpayments to our Deposit Account No. 50-1302.

Respectfully submitted,  
HICKMAN PALERMO TRUONG & BECKER  
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